



Docket No.: 51410/P003US/09705003
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Charles L. Dennis

Application No.: 08/997,489

Confirmation No.: 1370

Filed: December 23, 1997

Art Unit: 3627

For: SYSTEM AND METHOD FOR
CONTROLLING FINANCIAL
TRANSACTIONS OVER A WIRELESS
NETWORK

Examiner: A. J. Rudy

SECOND APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Second Appeal Brief under 37 C.F.R. § 41.37 to the Board of Patent Appeals and Interferences in furtherance of the Second Notice of Appeal filed on April 11, 2006. Appellant believes no fee is due for the filing of this Second Appeal Brief. *See* M.P.E.P. § 1204.01.

This brief contains items under the following headings as required by 37 C.F.R. § 41.67(c)(1) and M.P.E.P. § 1205.02:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Issues to be Reviewed on Appeal
- VII. Argument
- Claims Appendix
- Evidence Appendix
- Related Proceedings Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Openwave Systems Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 6 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 1-106, 113-125

2. Claims pending: 107-112

3. Claims rejected: 107-112

C. Claims On Appeal

The claims on appeal are claims 107-112

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed with respect to the present application. Accordingly, the claims listed in the attached Claims Appendix are the claims as indicated in the paper filed by Appellants on February 4, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

With regard to claim 107, the claimed subject matter is a method comprising the steps of receiving by a wireless device in communication with a wireless network financial data

from a plurality of point of sale locations (page 8, lines 4-12; Figure 1, items 13, 17, and 100), wherein said financial data relates to customer transactions at said plurality of point of sale locations (page 8, lines 18-29, page 9, lines 1-2; Figure 1, item 100), identifying a geographic area to a customer who has initiated a transaction using said wireless device by determining a specific wireless cell that is in communication with said customer's wireless device (page 9, lines 12-28; Figure 1, items 13, 19, and 100), and determining which of said plurality of point of sale locations are within said geographic area (page 9, lines 12-28; Figure 1, items 13, 19, and 100); if only one of said point of sale locations is within said geographic area, then communicating financial data for said point of sale location to said customer's wireless device over said wireless network (page 10, lines 21-29; Figure 1, items 13, 17, and 100), and if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area (page 9, lines 29-30, page 10, lines 1-13; Figure 4, items 401-403), and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network (page 10, lines 21-29; Figure 1, items 13, 17, and 100).

VI. ISSUES TO BE REVIEWED ON APPEAL

Whether claims 107-112 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Salimando (U.S. Patent No. 5,561,704, hereinafter *Salimando*) in view of Bickham et al. (U.S. Patent No. 5,530,438, hereinafter *Bickham*).

VII. ARGUMENT

A. General

This case has now been pending before the United States Patent and Trademark Office for over eight years. Several restriction requirements and Office Actions have been issued without any continuations ever being filed. Many Office Actions were improperly made Final, and the finality in each case was later withdrawn. In some Office Actions, Appellee asserted rejections against the claims using references that clearly did not constitute prior art. Moreover, there have been long periods of unexplained delay in the examination of

this application, such as, for example, from September 2001 to February 2003, a period of 17 months.

In an effort to expedite prosecution of the this case, Appellant filed a Appeal Brief on September 8, 2005. In a Final Office Action mailed on January 27, 2006, Appellee re-opened prosecution of the present application.

Appellant points out that the latest Final Office Action contained new grounds of rejection for claims 107-112. An Office Action containing a new ground of rejection may be made final only if the new ground of rejection was necessitated by amendment or was based on information presented in an information disclosure statement. *See* M.P.E.P. § 1207.04. Appellant has not filed any such amendment nor information disclosure statement. Therefore, the latest Office Action has *again* been improperly made final.

As noted in Appellant's first Appeal Brief, which is hereby incorporated by reference, claims 108-111 have yet to be properly examined. Appellant has not received a full and fair hearing, and has not had an opportunity to explore the patentability of these claims.

B. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 107-112 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Salimando* in view of *Bickham*.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Appellant respectfully asserts that the rejection does not satisfy the basic criteria.

1. Claim 107

a. Lack of All Claimed Limitations

Claim 107 recites, in part, “receiving . . . financial data from a plurality of point of sale locations, wherein said financial data relates to customer transactions at said plurality of point of sale locations.” Appellant respectfully asserts that the combination of *Salimando* with *Bickham* does not teach or suggest the aforementioned limitation. In rejecting claim 107, Appellee admits that:

Salimando does not specifically disclose the term financial data, nor specifically disclose the term point of sale (pos) location. However it is noted that in broad scope and content the data transmitted by Salimando may be broadly construed as within the realm of financial data. The term financial data is extremely broad in scope and content. Final Office Action at page 2.

Appellant respectfully disagrees. *Salimando* discloses a system and method by which a caller in a mobile vehicle requiring service determines his location and transmits that location information along with a service request to a directory station. *Salimando* at Abstract; col. 3, lines 15-45. According to *Salimando*, the directory station determines the telephone number of a provider that is closest to the caller and may transmit that provider’s phone number to the caller. *Id.* Therefore, while *Salimando* may disclose receiving a phone number from a directory station, but it does not teach or suggest receiving financial data from a point of sale location. Contrary to Appellee’s assertions, Appellant believes that a “phone number” cannot be reasonably construed “as within the realm of financial data.” Moreover, *Salimando*’s directory station is clearly not a point of sale location.

In an attempt to cure these deficiencies, Appellee introduces *Bickham*. Office Action at page 2. However, Appellee’s only statement with respect to *Bickham* is that “Bickham discloses a [point of sale] system, e.g., 106, a wireless device, e.g., 102, financial transaction data, e.g., 122, a customer, e.g., 118, and a customer local, e.g., 120.” Final Office Action at page 2. Appellee has not articulated any cognizable argument as to how the combination of *Salimando* and *Bickham* would teach or suggest *any of the steps* recited in claim 107, and Appellant asserts that this combination of references does not teach or suggest such steps.

Claim 107 also recites, in part, “identifying a geographic area to a customer who has initiated a transaction using said wireless device, said identifying step accomplished by determining a specific wireless cell that is in communication with said customer’s wireless device” Appellant respectfully asserts that the combination of *Salimando* with *Bickham* does not teach or suggest the aforementioned limitation, and that Appellee has not shown otherwise. In fact, Appellee merely states that:

To have determined a geographic area to the customer while receiving financial data from a pos for *Salimando* would have been obvious to one of ordinary skill in the art. Final Office Action at page 2.

Appellant respectfully disagrees. According to *Salimando*, it is the caller who determines the position of the vehicle he occupies. *Salimando* at col. 3, lines 15-20. Thus, a geographic area is not identified “to a customer,” as required in the claim. Moreover, while *Bickham* may disclose combining the location of the financial transaction with financial transaction information (*Bickham* at col. 3, lines 45-47), it does not teach or suggest “determining a specific wireless cell that is in communication with said customer’s wireless device,” as also recited in the claim. Appellant asserts that this combination of references does not teach or suggest the aforementioned step.

In addition, claim 107 recites, in part, “determining which of said plurality of point of sale locations are within said geographic area; if only one of said point of sale locations is within said geographic area, then communicating financial data for said point of sale location to said customer’s wireless device over said wireless network; and if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer’s wireless device over said wireless network.” Appellant respectfully asserts that the combination of *Salimando* with *Bickham* does not teach or suggest the aforementioned limitations, and that Appellee has not shown otherwise. Instead, Appellee merely states that:

[i]t is noted that intended use claim language, e.g., “for processing” or “if” is given less patentable weight than positively recited claim language, e.g., “receiving financial data” as recited from claim 1.” Further, if the “if”

language need not occur. Thus a non-event is not needed to fully meet Applicant's claim language. Office Action at page 3.

In response, Appellant points out that every limitation of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness, and the references when combined must teach or suggest all the claim limitations. *See* MPEP § 2143.03.

Appellant has failed to find any "intended use" claim language such as "for processing" in claim 107. Moreover, Appellant disagrees with Appellee's contention that the "if" statements need not occur. Claim 107 clearly recites that, once the plurality of point of sale locations are determined, either the step of "communicating financial data for said point of sale location to said customer's wireless device over said wireless network" or the step of "prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network" occurs depending upon whether "only one" or "more than one" point of sale locations are within said geographic area, respectively. Nonetheless, Appellee has not attempted to show how the combination of *Salimando* with *Bickham* teaches or suggests any of these steps.

Therefore, the combination of *Salimando* with *Bickham* does not teach or suggest all the claimed limitations, and Appellant submits that claim 107 is allowable for the reasons discussed above.

b. Lack of Motivation

Appellant respectfully asserts that there is no motivation or suggestion for the combination of references put forth by Appellee. *Salimando* discloses a proximity based toll free communication service whereby a phone number is retrieved by a caller in a mobile vehicle requiring service. *Salimando* at Title and Abstract. Meanwhile, *Bickham* discloses a method of providing an alert for a financial transaction whereby a user is alerted to the occurrence of a financial transaction. *Bickham* at Title and Abstract. Simply put, Appellant asserts that a person of ordinary skill in the art would have no reason, suggestion, or motivation for combining *Salimando*'s phone number retrieval system with *Bickham*'

transaction alert system. Moreover, it seems that Appellee is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Appellant's disclosure. *See* M.P.E.P. § 2145(X)(A).

In arguing that *Salimando* and *Bickham* can be combined to meet the elements of claim 107, the Examiner states that that:

“The motivation for having done such would have been to implement common knowledge technology associated with wireless devices to process financial data, while pinpointing an customer’s position within a electronic communication system.” Final Office Action, page 3.

However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. In this case, the language of Appellee’s proposed motivation is, at best, merely a statement that the references can be combined, and does not state any desirability for making the modification. In addition, the language of the Appellee’s proposed motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the references can be combined and does not state any desirability for making the modification. Neither the prior art nor the knowledge available to a person of ordinary skill in the art suggest the desirability of the combination, and Appellant asserts that there is no suggestion or motivation to combine *Salimando* and *Bickham*.

In sum, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art to combine *Salimando* with *Bickham* as suggested by the Appellee. Therefore, Appellant submits that claim 107 is allowable for the reasons discussed above.

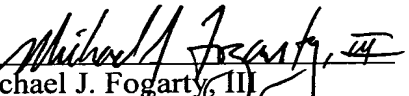
2. Claims 108-112

Claims 108-112, although indicated as rejected, are not specifically addressed within the body of the Office Action. Final Office Action, pages 2-3.

Appellee's rejection of claims 108-112, *en masse*, does not comport with Office policy. Appellant respectfully points out that "[i]n accordance with the Patent Law, '[w]henever, on examination, any claim for a patent is rejected, or any objection . . . made', notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given." M.P.E.P. § 707. As such, Appellee has not "clearly articulate[d] any rejection early in the prosecution process so that Appellant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." M.P.E.P. § 706. Appellant is entitled to a full and fair hearing. M.P.E.P. § 706.07. Claims 108-112 have not been individually examined. Appellant has not received a full and fair hearing, and has not had an opportunity to explore the patentability of these claims.

Dated: April 11, 2006

Respectfully submitted,

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CLAIMS APPENDIX

Claims Involved in the Appeal of Application Serial No. 08/997,489

Claims 1-106 canceled.

107. (Previously Presented) A method comprising the steps of:

receiving, by a wireless device in communication with a wireless network, financial data from a plurality of point of sale locations, wherein said financial data relates to customer transactions at said plurality of point of sale locations;

identifying a geographic area to a customer who has initiated a transaction using said wireless device, said identifying step accomplished by determining a specific wireless cell that is in communication with said customer's wireless device; and

determining which of said plurality of point of sale locations are within said geographic area;

if only one of said point of sale locations is within said geographic area, then communicating financial data for said point of sale location to said customer's wireless device over said wireless network; and

if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network.

108. (Previously Presented) The method of claim 107 further comprising the steps of:

determining whether said customer has verified said financial data that was communicated to said customer's wireless device.

109. (Previously Presented) The method of claim 107 wherein said prompting step further comprises:

causing said customer's wireless device to display a list of said point of sale locations within said geographic area; and

receiving information from said customer's wireless device identifying said selected point of sale location.

110. (Previously Presented) The method of claim 107 wherein said prompting step further comprises:

playing a voice message to said customers via said wireless device, wherein said voice message comprises a list of said point of sale locations; and

receiving information from said customer's wireless device identifying said selected point of sale location.

111. (Previously Presented) The method of claim 107 wherein said identifying step further comprises the step of:

identifying a specific antenna that is communicating with said customer's wireless device.

112. (Previously Presented) The method of claim 107 wherein said financial data comprises:

product information detected using a bar code scanner coupled to a customer's wireless device.

Claims 113 –125 canceled.

EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Examiner is being submitted.

RELATED PROCEEDINGS APPENDIX

There are **no related proceedings**.